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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,112	12/11/2003	Eugene M. Cummings	1434-0006	7859

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EXAMINER

TAYLOR, APRIL ALICIA

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,112

Applicant(s)

CUMMINGS, EUGENE M.

Examiner

April A. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 15-48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/2004; 06/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains legal phraseology such as "means" (see lines 4-6). Correction is required. See MPEP § 608.01(b).
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. Claims 1-48 are objected to because of the following informalities:
 - Re claim 1: Substitute "adapted to receive" with -- for receiving -- (see line 3).
 - Re claim 1: Substitute "said ballot" with -- said hand-markable physical ballot -- (see lines 5 and 10-12, respectively).
 - Re claim 2: Insert -- hand-markable -- before "physical ballot".
 - Re claims 2-4 and 6-8: Substitute "A" with -- The -- (see line 1).
 - Re claim 5: Substitute "hand-markable paper ballot" with -- hand-markable physical ballot -- (see line 2).
 - Re claim 5: Substitute "adapted to receive" with -- for receiving -- (see line 2).
 - Re claim 5: Substitute "the ballot" with -- the hand-markable physical ballot -- (see lines 4, 5, and 11, respectively).

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Re claim 5: Substitute "said voting terminal" with -- said ballot marking terminal -- (see line 11).

Re claim 6: Insert -- hand-markable -- before "physical ballot".

Re claim 9: Substitute "adapted to receive" with -- for receiving -- (see line 2).

Re claim 9: Substitute "the ballot" with -- the hand-markable physical ballot -- (see page 45, lines 1 and 4, respectively).

Re claim 10: Substitute "A" with -- The -- (see line 1).

Re claim 10: Insert -- hand-markable -- before "physical ballot" (see line 1).

Re claim 11: Substitute "A voting system" with -- The ballot marking terminal -- (see line 1).

Re claim 12: Substitute "adapted to receive" with -- for receiving -- (see line 3).

Re claim 12: Substitute "the ballot" with -- the hand-markable physical ballot -- (see lines 5 and 12, respectively).

Re claim 13: Insert -- hand-markable -- before "physical ballot".

Re claim 15: Substitute "said first ballot" with -- said first hand-markable physical ballot -- (see line 2).

Re claim 15: Substitute "said second ballot" with -- said second hand-markable physical ballot -- (see line 3).

Re claim 15: Substitute "being adapted to receive" with -- receives -- (see line 5).

Re claim 15: Substitute "said ballots" with -- said hand-markable physical ballots - (see lines 5 and 8).

Re claim 15: Substitute "adapted to" with -- for -- (see line 8).

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Re claim 15: Substitute "said first and second ballot" with -- said first and second hand-markable physical ballot -- (see lines 9 and 10).

Re claim 15: Substitute "said ballot" with -- said hand-markable physical ballot -- (see page 47, line 1).

Re claim 15: Substitute "being further adapted to return" with -- returns -- (see page 47, line 11).

Re claims 16-27: Substitute "A" with -- The -- (see line 1).

Re claim 17: Insert -- hand-markable -- before "physical ballots" (see line 1).

Re claim 17: Substitute "said ballots" with -- said hand-markable physical ballots -
- (see line 2).

Re claim 24: Substitute "said ballots" with -- said hand-markable physical ballots -
- (see lines 1 and 3).

Re claim 24: Substitute "said transport" with -- said ballot transport mechanism --
(see line 3).

Re claim 25: Substitute "said ballots" with -- said hand-markable physical ballots -
- (see lines 1 and 3).

Re claim 25: Substitute "said transport" with -- said ballot transport mechanism --
(see line 3).

Re claim 25: Insert -- device -- after "said ballot interface" (see line 5).

Re claim 26: Substitute "said ballots" with -- said hand-markable physical ballots -
- (see lines 1 and 3).

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Re claim 26: Substitute "said transport" with -- said ballot transport mechanism -- (see line 3).

Re claim 26: Substitute "is further adapted to reject" with -- rejects -- (see line 6).

Re claim 26: Substitute "a ballot" with -- a hand-markable physical ballot -- (see line 6).

Re claim 28: Substitute "said ballots" with -- said hand-markable physical ballots - (see lines 7 and 10).

Re claim 28: Substitute "being adapted to receive" with -- receives -- (see line 7).

Re claim 28: Substitute "adapted to" with -- for -- (see line 9).

Re claim 28: Insert -- ballot marking -- before "terminal" (see lines 11, 13, 15, and 21, respectively).

Re claim 28: Substitute "said ballot" with -- said hand-markable physical ballot -- (see line 13).

Re claim 28: Insert -- ballot -- before "transport mechanism" (see line 14).

Re claim 28: Substitute "being further adapted to return" with -- returns -- (see line 24).

Re claims 29-40: Substitute "A" with -- The -- (see line 1).

Re claim 30: Insert -- hand-markable -- before "physical ballot" (see line 1).

Re claims 30: Substitute "said ballots" with -- said hand-markable physical ballots -- (see line 2).

Re claim 37: Substitute "said ballots" with -- said hand-markable physical ballots - (see line 1).

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Re claim 37: Substitute "said ballot" with -- said hand-markable physical ballot --
(see line 3).

Re claim 37: Substitute "said transport" with -- said ballot transport mechanism --
(see line 3).

Re claim 38: Substitute "said ballots" with -- said hand-markable physical ballots -
- (see line 1).

Re claim 38: Substitute "said ballot" with -- said hand-markable physical ballot --
(see page 52, line 1).

Re claim 38: Substitute "said transport" with -- said ballot transport mechanism --
(see page 52, line 1).

Re claim 38: Insert -- device -- after "said ballot interface" (see page 52, line 2).

Re claim 39: Substitute "said ballots" with -- said hand-markable physical ballots -
- (see line 1).

Re claim 39: Substitute "said ballot" with -- said hand-markable physical ballot --
(see line 3).

Re claim 39: Substitute "said transport" with -- said ballot transport mechanism --
(see line 3).

Re claim 39: Substitute "is further adapted to reject" with -- rejects -- (see line 5).

Re claim 41: Substitute "said ballots" with -- said hand-markable physical ballots -
- (see lines 7 and 10).

Re claim 41: Substitute "being adapted to receive" with -- receives -- (see line 7).

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Re claim 41: Insert – ballot marking – before “terminal” (see page 53, lines 1 and 4).

Re claim 41: Substitute “said ballot” with -- said hand-markable physical ballot -- (see page 53, line 3).

Re claim 41: Insert – ballot – before “transport mechanism” (see page 53, line 3).

Re claims 42-48: Substitute “A” with – The – (see line 1).

Re claim 45: Substitute “said transport” with -- said ballot transport mechanism -- (see line 3).

Re claim 46: Substitute “said transport” with -- said ballot transport mechanism -- (see line 3).

Re claim 47: Substitute “said transport” with -- said ballot transport mechanism -- (see line 3).

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/347,528 (hereinafter '528). Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present claimed invention and '528 Application the Applicant claim:

Re claim 1: A voting system comprising:

a hand-markable physical ballot adapted to receive at least one voter-detectable mark indicating the voter's selection of a candidate from the slate of one or more candidates, said ballot providing the names of and an associated marking space for each candidate in said slate of candidates (see page 8, lines 14-21 in col. 2);

a ballot marking terminal for displaying to the voter one or more menus presenting a choice of candidates from said slate of candidates, and for receiving an input from the voter indicating the selection of a candidate from said slate of candidates, said ballot marking terminal receiving said ballot and in response to said voter input, providing a voter-detectable mark in the marking space corresponding to said selected candidate and returning said ballot to the voter (see page 8, lines 22-30 in col. 2); and

a ballot scanning device for receiving said ballot and recording said voter-detectable mark in said marking space associated with said selected candidate as a vote cast for said selected candidate (see page 8, lines 31-34 in col. 2).

Re claim 5: A voting system comprising:

a ballot marking terminal for providing to the voter one or more menus presenting a choice of candidates from the slate of candidates, and for receiving an input from the

voter indicating the selection of a candidate from said slate of candidates, said ballot marking terminal receiving the ballot and in response to said voter input to said voting terminal, providing a voter-detectable mark in the marking space corresponding to said selected candidate (see page 8, line 54 in col. 2 to page 9, line 2 in col. 1).

Re claim 9: A ballot marking terminal comprising:

a transport mechanism for receiving the ballot (see page 9, line 1 in col. 2);

a user interface providing to the voter one or more menus presenting a choice of candidates from the slate of candidates, and for receiving an input from the voter indicating the voter's selection of a candidate from the slate of candidates (see page 9, line 33+ in col. 1); and

a marking head responsive to the voter input for providing a voter-detectable mark in the marking space corresponding to the selected candidate (see page 9, lines 3-4 in col. 2).

As to claims 2-4, 6-8, and 10-14 of the instant application, the '528 Application meets all the limitation as set forth in claims 2-4, 6-12, and 14-19.

Thus, in respect to the above discussions, it would have been obvious to an artisan at the time the invention was made to use the teachings of claims 1-19 of the '528 Application as a general teaching for a voting system to perform the same functions as claimed by the present application. The instant claims obviously encompass the claimed invention of the '528 Application and differ only in terminology.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4-6, 8, 12, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Petersen et al (US 2004/0169077) (hereinafter Petersen).

Re claims 1, 2, 5, 6, 12, and 13: Petersen teaches a combination electronic and paper ballot voting system comprising: a hand-markable physical ballot 34 for receiving at least one voter-detectable mark indicating the voter's selection of a candidate from a slate of one or more candidates, the ballot 34 providing the names of and an associated marking space for each candidate in the slate of candidates;

a ballot marking terminal for displaying to the voter a menu presenting a choice of candidates from the slate of candidates, and for receiving an input from the voter indicating the selection of a candidate from the slate of candidates, the ballot marking terminal receiving the ballot 34 and in response to the voter input, providing a voter-detectable mark in the marking space corresponding to the selected candidate and returning the ballot to the voter;

a ballot scanning device for receiving the ballot 34 and recording the voter-detectable mark in the marking space associated with the selected candidate as a vote cast for the selected candidate; and

wherein the hand-markable physical ballot is a paper ballot. (See paragraphs 324-332 and 384-393)

Re claims 4 and 8: Petersen teaches wherein the menu presented to the voter is coordinated visual and aural menu (see figure 9; and paragraph 341).

Allowable Subject Matter

8. Claims 15-48 are allowable over the prior art.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art to Petersen teaches a combination electronic and paper ballot voting system, however the prior art of record, taken alone or in combination, fail to teach or fairly suggest, in conjunction with other limitations in the claims, a first ballot having a first format code; a second ballot having a second format code; a ballot transport mechanism; a memory device for storing first and second ballot format data in association with the first and second ballot format codes; and a ballot interface device for reading the format codes on the ballot received by the ballot transport mechanism.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Biddulph (US 2005/0211778) discloses a voting system and method that utilizes a computer to authenticate, poll and store user responses to a

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customized questionnaire; and Vadura et al (US 2004/0195323) discloses an electronic voting system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Taylor whose telephone number is (571) 272-2403. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [april.taylor@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AAT

30 September 2005

DANIEL STCYR
PRIMARY EXAMINER

